

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Jay S. Walker, Magdalena) Group Art Unit: 3714
Fincham, Michiko)
Kobayashi, Russell P.) Examiner: FRENEL, Vanel
Sammon, Andrew P.)
Golden, Geoffrey M.) **APPEAL BRIEF**
Gelman, Terry Mayfield)
) Attorney Docket No.: 00-007
Application No.: 09/609,253)
)
Filed: June 30, 2000)
For: METHODS AND APPARATUS)
FOR INCREASING AND/OR)
MONITORING A PARTY'S)
COMPLIANCE WITH A)
SCHEDULE FOR TAKING)
MEDICINES)
)

**BOARD OF PATENT APPEALS
AND INTERFERENCES**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants initiate an appeal to the Board of Patent Appeals and Interferences following the Examiner's rejection of Claims 2, 3, 5-47, 49, 50 and 116-125 in the Office Action mailed January 30, 2008.

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REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, Two High Ridge Park, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and Appellants' assignee know of no interferences or appeals that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 2, 3, 5-47, 49, 50 and 116-125 are pending.

Claims 2, 3, 5-47, 49, 50 and 116-125 are rejected and are being appealed.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Office Action mailed January 25, 2008.

SUMMARY OF CLAIMED SUBJECT MATTER

Claims 2, 49 and 116 are the only independent claims.

Concise explanations of the independent claims are provided below. As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification. Any such reference and / or accompanying explanation:

(i) is by way of example of the claimed subject matter only and is not a comprehensive description of the scope of the independent claim being discussed, nor a comprehensive listing of support in the specification for the independent claim being discussed;

(ii) might be potentially useful in clarifying the particular subject matter of the particular independent claim being discussed (and not other claims or “the invention” as a whole), unless explicitly stated otherwise; and

(iii) is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, unless explicitly stated otherwise.

Additionally, any explanation or reference to the specification which refers to more than one claim, or is utilized in the explanation of more than one claim, is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, and is not to be considered as indicating any equivalence of any claims or parts of a claim.

1. Independent Claim 2

In accordance with one or more embodiments, independent Claim 2 recites a method.

The method comprises storing information regarding a first medicine.
Specification at page 3:21-22; 13:6-8; FIGS. 1B-1E and FIGS. 7A and 7B.

The method further comprises wirelessly communicating a signal between a first container adapted to store the first medicine and a second container, the second container adapted to store a second medicine, the signal including an indication of a number of times that the second container is beyond a range in which the first container is able to communicate with the second container.
Specification at page 3:22-25; 13:6-8; 36:30; FIGS. 1B-1E and FIGS. 7A and 7B.

The method further comprises generating at least one code based at least in part on the signal, the at least one code indicating whether at least one party has complied with a schedule for taking the first medicine and the second medicine.
Specification at page 4:8-11; 13:11-12; FIGS. 1B-1E and FIGS. 7A and 7B.

2. Independent Claim 49

In accordance with one or more embodiments, independent Claim 49 recites a medicine container.

The medicine container comprises a medicine storage region adapted to store a medicine. Specification at page 3:21-22; 13:6-8; FIGS. 1B-1E and FIGS. 7A and 7B.

The medicine container further comprises a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container. Specification at page 3:22-25; 13:6-8; FIGS. 1B-1E and FIGS. 7A and 7B.

3. Independent Claim 116

In accordance with one or more embodiments, independent Claim 116 recites a method.

The method comprises obtaining a first container for storing a first medicine, the first container being capable of wirelessly communicating with a second container for storing a second medicine. Specification at page 3:22-25; 13:6-8; FIGS. 1B-1E and FIGS. 7A and 7B.

The method further comprises storing a first medicine in the first container. Specification at page 3:21-22; 13:6-8; FIGS. 1B-1E and FIGS. 7A and 7B.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Rejection of Claims 49 and 50 under Section 102(a) in view of Reber

Claims 49 and 50 stand rejected under 35 U.S.C. §102(a) as allegedly being anticipated by U.S. Patent No. 5,950,632 to Reber (“Reber” hereinafter).

2. Rejection of Claims 116-125 under Section 102(a) in view of Reber

Claims 116-125 stand rejected under 35 U.S.C. §102(a) as allegedly being anticipated by U.S. Patent No. 5,950,632 to Reber (“Reber” hereinafter).

3. Rejection of Claims 1, 3 and 5-47 under Section 103(a) in view of Reber, de la Huerga and Yarin

Claims 2, 3 and 5-47 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Reber in view of U.S. Patent No. 6,529,446 to de la Huerga et al. (hereinafter “de la Huerga”) and further in view of U.S. Patent No. 6,294,999 to Yarin et al. (hereinafter “Yarin”).

ARGUMENT

1. Summary of Arguments

All of the rejections are inappropriate and Appellants respectfully request that the rejections be reversed.

1.1. Section 102(a) – Reber

1.1.1. Claims 49 and 50

Independent claim **49** is directed to a medicine container that includes:

a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container.

The Present Office Action admits at page 6 that “[a]s best understood, the combination of Reber and de la Huerga do not explicitly disclose wirelessly communicating a signal between the first container and the second container the second container adapted to store a second medicine.” It therefore follows that Reber alone does not teach or suggest a first medicine container configured to wirelessly communicate with a second medicine container.

1.1.2. Claims 116-125

Independent claim **116** is directed to a method that includes:

obtaining a first container for storing a first medicine, the first container being capable of wirelessly communicating with a second container for storing a second medicine; and

storing a first medicine in the first container.

As noted above, the Present Office Action admits at page 6 that “[a]s best understood, the combination of Reber and de la Huerga do not explicitly disclose

wirelessly communicating a signal between the first container and the second container the second container adapted to store a second medicine.”

Accordingly, independent claims **49** and **116**, and dependent claims **50** and **117-125** should be allowable over the cited references for at least the same reasons as claim **2**.

1.2. Section 103(a) – Reber, de la Huerga and Yarin

Independent claim 2 is directed to a method that includes:

wirelessly communicating a signal between a first container adapted to store the first medicine and a second container, the second container adapted to store a second medicine.

There is no disclosure, teaching or suggestion in Reber, de la Huerga or Yarin, alone or in combination, of these features. The Examiner admits that Reber and de la Huerga fail to teach such a feature (Present Office Action, page 6), and Appellant’s 12/07 Appeal successfully established that Reber and de la Huerga do not meet these limitations. The Present Office Action relies on Fig. 3 and Col. 9:21-41 of Yarin as “suggest[ing] that the method having wirelessly communicating a signal between the first container and the second container adapted to store a second medicine [sic].” But this cited portion of Yarin discloses that the medicine containers are capable of communicating only with the smart tray 12 and **not** with each other. As with Reber, Yarin does **not** teach or suggest “wirelessly communicating a signal between a first container and a second container.” Thus, the Examiner has misinterpreted the teaching of the cited references.

In view of the above remarks, Appellants respectfully submit that the cited art does **not** teach or suggest the features recited by claim 2. Accordingly, the

rejection of claim 2 under Section 103(a) cannot stand. In addition, dependent claims 3 and 5-47 should be allowable for at least the same reasons as claim 2.

2. Form of Appeal Brief

In separate arguments of patentability for separate claims (or groups of claims), Appellants have, where possible, referred to prior arguments to avoid undue repetition.

3. **Argument**

3.1. **Claims 49-50 and 116-125 Are Not Anticipated by Reber**

Independent claim **49** is directed to a medicine container that includes:

a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container.

Independent claim **116** is directed to a method that includes:

obtaining a first container for storing a first medicine, the first container being capable of wirelessly communicating with a second container for storing a second medicine; and

storing a first medicine in the first container.

The Present Office Action admits at page 6 that “[a]s best understood, the combination of Reber and de la Huerga do not explicitly disclose wirelessly communicating a signal between the first container and the second container the second container adapted to store a second medicine.” This admission that Reber fails to teach or suggests a first medicine container configured to wirelessly communicate with a second medicine container squarely contradicts the premise for this rejection. Similarly, de la Huerga and Yarin, cited against other pending claims, also fail to disclose, teach or suggest these limitations. Accordingly, independent claims **49** and **116**, and dependent claims **50** and **117-125** should be allowed over the cited references.

3.1.1. **Applicable Law: Section 102**

3.1.1.1. *Prima Facie burden*

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then

without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D 1443, 1444 (Fed. Cir. 1992).

3.1.1.2. *Substantial evidence required for all factual findings*

The Board is not permitted to accept conclusory, unsupported findings made by the Examiner that are not supported by substantial evidence made of record. All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. *In re Gartside*, 203 F.3d 1305, 1315, 53 U.S.P.Q.2D 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described “substantial evidence” in the following manner:

Substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); *see also*, *Dickinson v. Zurko*, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 1935, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (“Zurko III”). “[R]eview under this standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency’s decision.” *Universal Camera Corp. v. NLRB*, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); *Zurko III*, 527 U.S. at 162.

3.1.1.3. *Anticipation*

There must not be any differences between the claimed invention and the prior art disclosure, as viewed by a person of ordinary skill in the art, for anticipation to exist. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2D 1001 (Fed. Cir. 1991). Thus, the absence of any claim

element from the reference negates anticipation. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 160 (Fed. Cir. 1986).

Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference.

Minnesota Min. & Mfg. Co., v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559, 24 U.S.P.Q.2D 1321 (Fed. Cir. 1992); *Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 U.S.P.Q.2D 1496 (Fed. Cir. 1995).

Further, as explained in *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1473, 43 U.S.P.Q.2D 1481, 1490 (Fed. Cir. 1997):

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. *See In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990) (“The [prior art] reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.” (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.

3.1.1.4. Claim interpretation must be consistent with the specification

During examination, claims are given their broadest reasonable interpretation that those skilled in the art would reach, consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D 1664, 1667 (Fed. Cir. 2000); *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2D 1464, 1468 (Fed. Cir. 1999). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever

enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2D 1023, 1027 (Fed. Cir. 1997).

3.1.2. By the Office Action's Own Admission, Reber Fails to Disclose All the Limitations of Claims 49 and 116

The Office Action admits at page 6 that "[a]s best understood, the combination of Reber and de la Huerga do not explicitly disclose wirelessly communicating a signal between the first container and the second container the second container adapted to store a second medicine." This statement is completely incompatible with the Office Action's allegations that Reber discloses "*a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container,*" or a "*first container being capable of wirelessly communicating with a second container for storing a second medicine,*" as recited by Claims 49 and 116 respectively. At the very least, the §102(a) rejections in view of Reber are clearly erroneous and should be withdrawn. In fact, none of the references applied by the Office Action disclose, teach or suggest these limitations.

In a described embodiment of Reber, a communication apparatus 50 (Fig. 2) acts as a base station to communicate wirelessly with one or more medicine containers 52 (col. 4, lines 27-40). In another implementation of Reber, a communication apparatus 100 (Fig. 3) communicates with each of three medicine containers (102, 104, 106) by reading machine-readable data (112, 120, 126) from a label (110, 116, 124) attached to each medicine container (col. 7, line 55 to col. 8, line 5). Thus, Reber teaches the use of a single, central communication apparatus or base station for communicating with one or more medicine containers, and does not disclose, teach or suggest communication, direct or otherwise, between or among the containers themselves.

3.1.3. The Examiner's Conclusion Contradicts Its Own Statements and Ignores the Findings of the Appellants' Two Prior Appeals

The Present Office Action alleges at page 2 that Reber discloses “a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container,” directly contradicting the Office Action’s admission, at page 6 of the same Office Action, that “Reber and de la Huerga do not explicitly disclose wirelessly communicating a signal between the first container and the second container.” The source of this discrepancy appears to be the fact that the Examiner has copied a previously withdrawn rejection from a prior Office Action in lieu of performing analysis of the claim. The Office Action, mailed January 17, 2007 (hereinafter the “1/07 Office Action”), contained two grounds of rejection: claims 49, 50 and 116-125 rejected under §102(a) in view of Reber (copied verbatim into the Present Office Action); and claims 2, 3 and 5-47 rejected under §103(a) in view of Reber and de la Huerga (combined with Yarin in the Present Office Action).

The subsequent Final Office Action, mailed on July 26, 2007 (hereinafter the “7/07 Office Action”), withdrew the §102 rejection and instead rejected all pending claims under §103 as being unpatentable over Reber in view of de la Huerga. In response, Appellants filed an appeal and accompanying pre-appeal request for review on December 21, 2007 (hereinafter the “12/07 Appeal”). The 12/07 Appeal successfully argued, *inter alia*, that neither Reber nor de la Huerga teaches or suggests all the limitations of the claims. Prosecution was reopened on this basis and the Present Office Action, mailed on January 30, 2008, explicitly states at page 2 that “Applicant’s arguments filed on 12/12/07 [sic] have been

persuasive, therefore the prior Office Action has been withdrawn and a new Office Action is hereby presented.”

Despite the clear admission by the Office that not even the combination of Reber and de la Huerga shows these limitations, the present Office Action has copied its previously withdrawn §102 rejection of 49, 50 and 116-125 from the 01/07 Office Action verbatim. The present § 102 rejections suffer from clear error(s) if they were included by mistake, and must be withdrawn.

3.2. Claims 2-3 and 5-47 Are Not Obvious In View of Reber, de la Huerga, or Yarin

3.2.1. Applicable Law: Section 103

3.2.1.1. Prima Facie burden

The examiner bears the initial burden of establishing a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2D 1780, 1783 (Fed. Cir. 1992); Oetiker, 977 F.2d at 1445. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. Oetiker, 977 F.2d at 1445.

To reject claims in an application under Section 103, an examiner must show an un rebutted *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1355, 47 U.S.P.Q.2D 1453, 1455 (Fed. Cir. 1998). The *prima facie* case is a procedural tool, and requires that the examiner initially produce evidence sufficient to support a ruling of obviousness; thereafter the burden shifts to the applicant to come forward with evidence or argument in rebuttal. In re Kumar, 418 F.3d 1361, 1366, 76 U.S.P.Q.2D 1048, 1050 (Fed. Cir. 2005). The patent applicant may attack the Examiner’s *prima facie* determination as improperly made out, or the

applicant may present objective evidence tending to support a conclusion of nonobviousness. Fritch, 972 F.2d at 1265. When rebuttal evidence is provided, the *prima facie* case dissolves, and the decision is made on the entirety of the evidence. Kumar, 418 F.3d at 1366; Oetiker, 977 F.2d at 1445.

3.2.1.2. *Graham Factual Inquiries Must Be Supported by Substantial Evidence*

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103. In Iron Grip Barbell Co. v. USA Sports Inc., the Federal Circuit explained how obviousness must be determined using the four-part Graham test:

we employ the four-part test set forth in Graham v. John Deere Co., 383 U.S. 1 (1966). This test requires us to examine

- (1) the scope and content of the prior art;
- (2) the level of ordinary skill in the art;
- (3) the differences between the claimed invention and the prior art; and
- (4) the objective evidence of nonobviousness. *Id.* at 17-18; see also 35 U.S.C. § 103 (2000).

392 F.3d 1317, 1320, 73 U.S.P.Q.2D (BNA) 1225 (Fed Cir. 2004); see also, Rouffet, 149 F.3d at 1355. U.S. Patent and Trademark Office policy is also to follow Graham. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 “35 U.S.C. 103; the Graham Factual Inquiries,” p. 2100-120, 8th ed., Rev. 2 (May 2004). Accordingly, during examination an examiner must conduct the four factual inquiries enunciated in Graham in determining obviousness of any claim.

The underlying factual determinations on which a conclusion of obviousness is allegedly based are reviewed to ascertain whether they are supported by

substantial evidence. In re Kumar, 418 F.3d at 1365 (citing Gartside, 203 F.3d at 1316). Unsupported assessments of the prior art are unacceptable for purposes of review. “Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise.” In re Zurko, 258 F.3d at 1385-86. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” Lee, 277 F.3d at 1344.

A determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666, 57 U.S.P.Q.2D 1161, 1168 (Fed. Cir. 2000) (citing Custom Accessories Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962, 1 U.S.P.Q.2D 1196, 1201 (Fed. Cir. 1986)). Ascertaining a level of ordinary skill in the art is necessary. M.P.E.P. § 2141.03. No such determination has been made by the Office Action.

In making the assessment of differences between the prior art and the claimed subject matter, Section 103 specifically requires consideration of the claimed invention “as a whole.” Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 75, U.S.P.Q.2D 1051, 1054 (Fed. Cir. 2005); Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275, 69 U.S.P.Q.2D 1686, 1690 (Fed. Cir. 2004). Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part and requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various

elements from the prior art and combined them in the claimed manner. Ruiz, 357 F.3d at 1275.

3.2.2. None of Reber, de la Huerga or Yarin Teaches or Suggests Communications Between Two Medicine Containers

Independent claim 2 is directed to a method that includes:

wirelessly communicating a signal between a first container adapted to store the first medicine and a second container, the second container adapted to store a second medicine.

There is no disclosure, teaching or suggestion in Reber, de la Huerga or Yarin, alone or in combination, of these features. The Examiner admits that Reber and de la Huerga fail to teach such a feature (Present Office Action, page 6), and Appellant's 12/07 Appeal successfully established that Reber and de la Huerga do not meet these limitations. The Present Office Action relies on Fig. 3 and Col. 9:21-41 of Yarin as "suggest[ing] that the method having wirelessly communicating a signal between the first container and the second container adapted to store a second medicine [sic]." But this cited portion of Yarin discloses that the medicine containers are capable of communicating only with the smart tray 12 and **not** with each other. As with Reber, Yarin does **not** teach or suggest "wirelessly communicating a signal between a first container and a second container."

Appellants respectfully submit that even after seven Office Actions that rely on combinations of these same two references, the Examiner continues to misinterpret Reber and de la Huerga. Appellants also respectfully submit that the Examiner misinterprets the newly cited reference Yarin. The present rejections relying upon these misinterpretations are in error.

Reber and Yarin both disclose a medical communication apparatus (See Reber, Fig. 1:20; Yarin Fig. 3:12) to assist end users in complying with

prescriptions for taking medicine. As discussed above with respect to Reber, a base station to communicate wirelessly with one or more medicine containers 52 (Fig. 2; col. 4, lines 27-40). Similarly, an embodiment of Yarin teaches a base station 12 that may identify medicine containers 34 via an RF electromagnetic tag reader 41. Thus, Reber and Yarin both teach to use a single, central communication apparatus or base station for communicating with one or more medicine containers, and both fail to disclose teach or suggest communication between or among the medicine containers themselves.

de la Huerga discloses an interactive medicine container or console that holds or organizes one or more medication containers or vials. Each vial has a memory strip containing medication and prescription information, and the console reads this information and interacts with a patient to remind them to take the medication (see de la Huerga, col. 3, line 62 to col. 4, line 3). In an illustrative embodiment, a medical organizing system 1300 (Fig. 42) has medicine containers that are removably secured to a dispenser 1310 (col. 47, lines 15-18). The dispenser 1310 comprises a housing having slots 1319 that are configured to mate with a plate 1104 of each medicine container (col. 47, lines 35-38). Each medicine container has an interactive label 1106 (see Figs. 35 and 37) that includes a memory strip 60 including contacts 62. When a medicine container is fully engaged in the slot 1319, the contacts 62 physically and electrically connect to contacts 1150 of dispenser 1310 so that a processor 1378 can then read the memory strip 60. Another embodiment includes a container having contacts 62 that are arranged as a series of stripes, and this container fits into a round hole of the dispenser, wherein the round hole is sized such that contacts 1150 of the dispenser are in electrical contact with the contacts 62 of a vial (col. 48, lines 10-26). Each of de la Huerga's example systems requires a medicine container to be

in electrical contact with contacts 62 of a dispenser to communicate information between the dispenser and the medicine container.

Thus, as Appellants have demonstrated, Yarin discloses features similar to Reber, that operate the same way as Reber, and which fail to meet the limitations of the claims for the same reasons as Reber. The medicine containers of Yarin cannot communicate with each other any more than the containers of Reber (or de la Huerga), alone or in combination.

In view of the above remarks, Appellants respectfully submit that the cited art does ***not*** teach or suggest the features recited by claim 2. Accordingly, the rejection of claim 2 under Section 103(a) cannot stand. In addition, dependent claims 3 and 5-47 should be allowable for at least the same reasons as claim 2.

3.2.3. The Examiner's Conclusion Contradicts Its Own Statements and Ignores the Findings of the Appellants' Two Prior Appeals

In the hopes of advancing prosecution by addressing the obvious examination errors, Appellants scheduled a telephonic interview with Examiner Frenel for April 30, 2008. Appellants specifically asked in advance that the Examiner be prepared to clarify the contradictory statements regarding the teachings of Reber (or lack thereof) at pages 2 and 6 of the Present Office Action. Despite this advance request, the Examiner during the interview was unwilling or unable to reconcile these statements, and instead suggested that Appellants' "address it in your response." The Examiner also could not identify any feature in Reber, de la Huerga or Yarin that disclosed wireless communication between two medicine containers, and was unable to articulate any differences between the Reber and Yarin references, or why Yarin succeeds in meeting the limitations where Reber fails.

Appellants filed a Pre-Appeal Request for Review on May 30, 2008, which presented the arguments contained in the present Appeal Brief, but that request was summarily denied without explanation. Applicants again attempted to schedule a telephonic interview to discuss the substance of Applicants' arguments prior to the filing of the present Brief, but although Appellants were able to speak with Examiners Frenel and Gart on July 30, 2008, the interview was limited to the contradiction between the allegations of the Section 102 rejection and the Office Action's admission that Reber and de la Huerga failed to teach the same recited limitations. No consensus was reached, necessitating the present Appeal Brief.

3.3. After three appeals and multiple examiner interviews, Appellants have not received a rejection that meets all the limitations of the claims.

Appellants respectfully submit that over the course of a prosecution that includes six Office Actions, three Appeals, and multiple Examiner interviews, the present application has already received a thorough and complete search as required by MPEP 904.3 ("It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search"). As such, Applicants respectfully submit that the search of the pending claims is complete and that a withdrawal of the pending rejections should be followed by allowance of the claims.

Applicants note that further search "in the mere hope of finding something" is not adequate justification for performing a new search of the present claims. See

MPEP 706.04 (“an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something.”) (citing *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001)).

Prosecution has already been reopened twice in what appears to be “the mere hope of finding something,” and each time, the resulting Office Action has ignored the language of the claims and even contradicted the findings of prior Office Actions and rehashed old arguments. Applicants submit that the prosecution is complete and should be closed, that the outstanding rejections should be withdrawn, and that the pending claims should be passed to issue.

CONCLUSION

The Examiner's rejection of the pending claims is improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Jerome DeLuca using the information provided below. If prosecution is reopened for any reason, Appellants respectfully request a telephonic or in-person interview prior to issuance of a new Office Action, so that the filing of a new Appeal might be avoided.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,

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APPENDIX A—CLAIMS INVOLVED IN THE APPEAL

All of the pending claims (Claims 1-21 and 23-32) are being appealed.

Claims 1, 2 and 28 are independent.

1. (CANCELLED)

2. A method comprising:

storing information regarding a first medicine;

wirelessly communicating a signal between a first container adapted to store the first medicine and a second container, the second container adapted to store a second medicine,

the signal including an indication of a number of times that the second container is beyond a range in which the first container is able to communicate with the second container; and

generating at least one code based at least in part on the signal, the at least one code indicating whether at least one party has complied with a schedule for taking the first medicine and the second medicine.

3. The method of claim 2 wherein wirelessly communicating a signal between the first container and a second container comprises at least one of transmitting information regarding the first medicine from the first container to the second container and receiving information regarding the second medicine from the second container.

4. (CANCELLED)

5. The method of claim 1 further comprising outputting the at least one code to at least one of a representative of an insurance company, a representative of a pharmacy and a representative of a medical facility.

6. The method of claim 2 further comprising detecting if the first container and the second container cannot communicate.

7. The method of claim 6 further comprising determining if the first container and the second container are separated by a distance that prevents the first container and the second container from communicating.

8. The method of claim 7 further comprising determining a time when the first container and the second container are at least initially separated by the distance that prevents the first container and the second container from communicating.

9. The method of claim 8 further comprising at least one of storing the time and transmitting the time.

10. The method of claim 2 further comprising determining a distance between the first container and the second container based on the signal.

11. The method of claim 10 further comprising at least one of storing the distance and transmitting the distance.

12. The method of claim 10 further comprising determining a change in the distance between the first container and the second container based on the signal.

13. The method of claim 12 further comprising at least one of storing the change in the distance and transmitting the change in the distance.

14. The method of claim 2 further comprising tracking a location of at least one of the first and the second containers.

15. The method of claim 14 wherein tracking the location of at least one of the first and the second containers comprises tracking the location of the at least one of the first and the second containers with a local positioning system.

16. The method of claim 15 further comprising identifying the location of the at least one of the first and the second containers with the local positioning system.

17. The method of claim 15 further comprising:
obtaining information regarding a position of the at least one of the first and the second containers with the local positioning system; and
determining a distance between the first and the second containers based at least in part on the information.

18. The method of claim 2 further comprising receiving information regarding a schedule for taking at least one of the first medicine and the second medicine.

19. The method of claim 18 further comprising storing the information.

20. The method of claim 18 wherein receiving information regarding a schedule for taking the first medicine comprises receiving the information regarding the schedule from at least one of a representative of an insurance company, a representative of a pharmacy, a representative of a medical facility, a representative of a manufacturer of at least one of the first and the second medicines and a party that is to take at least one of the first and the second medicines.

21. The method of claim 2 further comprising storing the first medicine in the first container.

22. The method of claim 21 further comprising detecting if a portion of the first medicine has been removed from the first container.

23. The method of claim 22 wherein detecting if a portion of the first medicine has been removed from the first container comprises detecting if the first container has been opened or closed.

24. The method of claim 22 wherein detecting if a portion of the first medicine has been removed from the first container comprises detecting a weight of the first container.

25. The method of claim 22 wherein detecting if a portion of the first medicine has been removed from the first container comprises detecting a count of the first medicine.

26. The method of claim 22 further comprising at least one of storing information regarding the portion and transmitting the information regarding the portion if the portion has been removed from the first container.

27. The method of claim 2 further comprising detecting if the second medicine has been stored in the second container.

28. The method of claim 27 further comprising detecting if a portion of the second medicine has been removed from the second container.

29. The method of claim 28 wherein detecting if the portion of the second medicine has been removed from the second container comprises receiving a signal from the second container that indicates that the portion of the second medicine has been removed from the second container.

30. The method of claim 28 further comprising at least one of storing information regarding the portion and transmitting the information regarding the portion if the portion has been removed from the second container.

31. The method of claim 30 further comprising storing the information regarding the second medicine, the information being stored within the first container.

32. The method of claim 28 further comprising determining if the first medicine is incompatible with the second medicine.

33. The method of claim 32 further comprising:
detecting if a party attempts to take the first medicine within a predetermined time period of taking the second medicine; and
generating a warning if the first medicine is incompatible with the second medicine if the first and second medicines are both taken during the predetermined time period.

34. The method of claim 33 further comprising storing an indicator of the warning.

35. The method of claim 33 further comprising transmitting an indicator of the warning.

36. The method of claim 35 wherein transmitting an indicator of the warning comprises transmitting the indicator of the warning to at least one of a representative of an insurance company, a representative of a pharmacy, a representative of a medical facility and a family member.

37. The method of claim 27 further comprising receiving information regarding the second medicine stored within the second container.

38. The method of claim 37 wherein receiving information regarding the second medicine stored within the second container comprises receiving information transmitted by the second container.

39. The method of claim 2 wherein the first and the second medicines are the same medicine.

40. The method of claim 2 wherein at least one of the first and the second containers comprises a micro-needle based device.

41. The method of claim 2 further comprising determining if the first container is positioned so as to communicate with the second container, and if not, attempting to prevent a party from accessing at least one of the first and the second medicines.

42. The method of claim 41 wherein preventing a party from accessing at least one of the first and the second medicines comprises preventing the party from opening at least one of the first and the second containers.

43. The method of claim 2 further comprising tracking a number of times the first container is opened or closed.

44. The method of claim 2 further comprising tracking a number of times the second container is opened or closed.

45. The method of claim 44 wherein tracking a number of times the second container is opened or closed comprises:

receiving a signal from the second container each time the second container is opened or closed; and

counting a number of signals received from the second container.

46. The method of claim 2 further comprising storing at least a portion of a medical history of a party within the first container.

47. The method of claim 2 further comprising storing information regarding a third medicine in the first container if the first container is refilled with the third medicine.

48. (CANCELLED)

49. A medicine container comprising:
a medicine storage region adapted to store a medicine; and
a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container.

50. The medicine container of claim 49 wherein the communication device comprises a transceiver.

51 - 115. (CANCELLED)

116. A method comprising:
obtaining a first container for storing a first medicine, the first container being capable of wirelessly communicating with a second container for storing a second medicine; and
storing a first medicine in the first container.

117. The method of claim 116 further comprising:

obtaining the second container; and
storing the second medicine in the second container.

118. The method of claim 117 further comprising positioning the first container and the second container so that the first container and the second container may communicate.

119. The method of claim 118 further comprising receiving a code that indicates that the first container and the second container are positioned so that the first container and the second container may communicate.

120. The method of claim 119 further comprising providing the received code to at least one party.

121. The method of claim 120 wherein the at least one party comprises at least one of a representative of an insurance company, a representative of a medical facility and a representative of a pharmacy.

122. The method of claim 120 wherein providing the received code comprises providing an image of the received code.

123. The method of claim 120 wherein providing the received code comprises entering the received code during a telephone call.

124. The method of claim 120 wherein providing the received code comprises e-mailing the received code.

125. The method of claim 116 further comprising obtaining a refill for the first container.

APPENDIX B—EVIDENCE

<NONE>

APPENDIX C—RELATED PROCEEDINGS

<NONE>